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## FACSIMILE TRANSMISSION COVER SHEET

Date: July 19, 2004  
Time: 2:05 PM  
From: Thomas T. Aquilla  
To: Examiner Gary Hartmann  
Re: Reply for 10/630,653  
Facsimile #: 703-872-9306  
Phone Code: 6442

Number of Pages (including this cover sheet): 6

Faxed with this cover sheet is the following:

Reply for 10/630,653

CERTIFICATE OF FACSIMILE TRANSMISSION	
FACSIMILE NO: <u>703-872-9306</u>	DATE: <u>7/19/2004</u>
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<u>Thomas T. Aquilla</u> Thomas T. Aquilla	

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

July 19, 2004

In Re application of: Michael Kozlowski  
Serial No: 10/630,653  
Filed: 07/30/2003  
For: APPARATUS AND METHOD FOR DRIVEWAY GUTTER  
Art Unit: 3671  
Confirmation No.: 8263  
Attorney Docket Number: SOZ-1

Mail Stop Non-Fee Amendment  
P.O. Box 1450  
Commissioner for Patents  
Alexandria, VA 22313-1450

## RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated June 29, 2004, please amend the above-identified application as follows

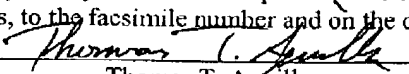
## REMARKS

The Restriction Requirement dated June 29, 2004 has been reviewed and its contents carefully noted. Reconsideration of this case is earnestly requested. Claims 1-23 remain in this case.

The Restriction Requirement

The Examiner has made a Restriction Requirement and has identified three (3) Groups of claims, as follows:

Group 1 - claims 1-10 and 21, drawn to a driveway and method for improving, classified in Class 404, subclass 15.

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Group II - claims 11-15 and 22, drawn to a method for improving a driveway, classified in Class 404, subclass 73.

Group III - claims 16-20 and 23, drawn to a method for improving a driveway, classified in Class 404, subclass 75.

The election of Group I and the species defined by claims 1-10 and 21 is hereby confirmed. However, the requirement for restriction, as best understood, is respectfully traversed.

The MPEP states the following with regard to stating a *prima facie* case of restriction between patentably distinct inventions:

"There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

#### **GUIDELINES**

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or

separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i) and § 808.01(a)".

### ARGUMENTS

The Examiner states that inventions I and II are related as product and process of use. The inventions can be shown to be distinct only if the Examiner shows either or both of the following: (1) the process for using the product as claimed **can be practiced with another materially different product** or (2) the product as claimed **can be used in a materially different process** of using that product (MPEP § 806.05(h))

In the instant case, the Examiner maintains that "Invention I could be used without the step of paving." It is respectfully submitted that such fact is wholly irrelevant. Moreover, even if true, that fact clearly does not address issues (1) or (2) above, as **the Examiner has not identified any materially different product or any materially different process of using the product whatsoever**. More particularly, even if the invention of Applicant's claim 1 can be practiced without the step of paving, the Examiner has not shown (or even alleged) (1) that the process for using the product as claimed **can be practiced with another materially different product (i.e., it is still the same product, not a materially different product, whether or not the paving step is deleted from the process)** or (2) that the product as claimed **can be used in a materially different process (i.e., it is still the same process of improving a driveway, not a materially different process, whether or not the paving step is omitted from the process)**. Thus, it is respectfully submitted that the Examiner has not made a *prima facie* restriction requirement in regard to Groups I and II.

The Examiner states that inventions I and III are related as product and process of use. The inventions can be shown to be distinct only if the Examiner shows either or both of the following: (1) the process for using the product as claimed **can be practiced with another materially different product** or (2) the product as claimed **can be used in a materially different process** of using that product (MPEP § 806.05(h)).

In the instant case, the Examiner maintains that "Invention I could be used without the step of removing a portion of pavement." It is respectfully submitted that such fact is wholly irrelevant. Moreover, even if true, that fact clearly does not address issues (1) or (2) above, as **the Examiner has not identified any materially different product or any materially different process of using the product whatsoever.** More particularly, even if the invention of Applicant's claim 1 can be practiced without the step of paving, the Examiner has not shown (or even alleged) (1) that the process for using the product as claimed can be **practiced with another materially different product (i.e., it is still the same product, not a materially different product, whether or not the paving step is deleted from the process)** or (2) that the product as claimed can be used in a **materially different process (i.e., it is still the same process of improving a driveway, not a materially different process, whether or not the paving step is omitted from the process).** Thus, it is respectfully submitted that the Examiner has not made a *prima facie* restriction requirement in regard to Groups I and III.

The Examiner states that inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other **only if the Examiner shows both of the following:** (1) that the subcombination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(d)).

In the instant case, the Examiner asserts that "Invention II has separate utility, such as raising sunken pavement, for example." It is respectfully submitted that the Examiner's naked assertion does not show **both of the required factors (1) and (2) above.** Moreover, the Examiner cites absolutely no authority whatsoever in support of the such factual assertions. If the Examiner's assertions are intended to indicate that the rejection is based on common knowledge in the art or "well known" prior art under MPEP 2144.03, then Applicant hereby traverses the Examiner's assertions.

It is respectfully submitted that the Examiner has **not** made a *prima facie* restriction requirement in regard to Groups II and III because the Examiner has not shown, by way of example, that one of the subcombinations has a separate utility.

Applicant respectfully requests that the restriction requirement be withdrawn. If the Examiner does not withdraw the restriction requirement, then Applicant requests that the Examiner state the restriction properly and in complete terms, so that Applicant may properly respond to the requirement. If the Examiner disagrees, or believes for any other reason that direct contact with Applicant's attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicant's attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:

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Dated: July 19, 2004